

Appl. No. 09/997,960
Substitute Appeal Brief dated 01/12/2007
Reply to Office Action of 12/14/2006

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re: Application of:	:
Bhupesh Gupta	:
	: Before the Examiner:
Serial No: 09/997,960	: Adam L. Basehoar
	:
Filed: 11/29/2001	: Group Art Unit: 2178
	:
Title: APPARATUS AND METHOD	: Confirmation No.: 4916
OF LINKING SUB-FOLDERS IN A	:
BOOKMARK FOLDER	:

SUBSTITUTE APPEAL BRIEF

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This substitute Appeal Brief is in response to the Notification of Non-Compliant Appeal Brief of December 14, 2006.

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BRIEF FOR APPLICANTS – APPELLANTS

(i)

Real Party in Interest

The real party in interest is International Business Machines Corporation (IBM), the assignee.

(ii)

Related Appeals and Interferences

There are no other appeals or interferences known to appellants, appellants' representative or assignee, which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(iii)

Status of Claims

Claims 1 - 25 have been finally rejected in an Office Action dated August 24, 2005. This appeal involves all the finally rejected claims.

(iv)

Status of Amendment

An "Amendment after Final" was not filed.

(v)

Summary of Claimed Subject Matter

The invention, as claimed in Claim 1, provides a computer implemented method of linking a first sub-folder to a second sub-folder in a bookmark folder. The computer implemented method comprises the steps of creating a copy of bookmarks stored in the first sub-folder, and storing the copy into the second sub-folder (see page 4, lines 3 – 11, page 13, lines 7 – 13, page 19, lines 11 – 28, page 19, line 32 to page 20, line 19).

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The invention, as claimed in Claim 7, provides a computer program product of linking a first sub-folder to a second sub-folder in a bookmark folder. The computer implemented method comprises code means for creating a copy of bookmarks stored in the first sub-folder, and storing the copy into the second sub-folder (see page 4, lines 3 – 11, page 13, lines 7 – 13, page 19, lines 11 – 28, page 19, line 32 to page 20, line 19). The code means are code means that allow the steps delineated in Figs. 14, 15 and 16 to be accomplished.

The invention, as claimed in Claim 13, provides a computer implemented apparatus for linking a first sub-folder to a second sub-folder in a bookmark folder. The computer implemented apparatus comprises means for creating a copy of bookmarks stored in the first sub-folder, and storing the copy into the second sub-folder (see page 4, lines 3 – 11, page 13, lines 7 – 13, page 19, lines 11 – 28, page 19, line 32 to page 20, line 19). The means are code means that allow the steps delineated in Figs. 14, 15 and 16 to be accomplished when processed by processor 202, 204 or 302.

The invention, as claimed in Claim 19, provides a computer system for linking a first sub-folder to a second sub-folder in a bookmark folder. The computer system comprises at least one memory device for storing code data (local memory 209, hard disk 232 of Fig. 2, main memory 304, disk 326, tape 328 or CD-ROM 330 of Fig. 3), at least one processor (processor 202, 204 of Fig. 2 or processor 302 of Fig. 3) for processing the code data to create a copy of bookmarks stored in the first sub-folder, and to store the copy into the second sub-folder (see page 4, lines 3 – 11, page 13, lines 7 – 13, page 19, lines 11 – 28, page 19, line 32 to page 20, line 19).

The invention, as claimed in Claim 25, provides a computer implemented method of linking a first sub-folder to a second sub-folder in a bookmark folder. The computer implemented method comprises the steps of copying all bookmarks stored in the first sub-folder into the second sub-folder, and assembling all bookmarks originally stored in the second sub-folder into a first group and the bookmarks copied into the second sub-folder into a second group

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in the second sub-folder such that when the second sub-folder is opened only bookmarks are displayed, the bookmarks in the first group being highlighted to distinguish the bookmarks in the first group from the bookmarks in the second group (see page 4, lines 3 – 11, page 13, lines 7 – 13, page 19, lines 11 – 28, page 19, line 32 to page 20, line 19).

(vi)

Grounds of Rejection to be Reviewed on Appeal

Whether Claims 1 - 24 were properly rejected under §103 as being unpatentable over Microsoft FrontPage Screen Shots in view of Khan

Whether Claim 25 was properly rejected under §103 as being unpatentable over Microsoft FrontPage Screen Shots in view of Khan and further in view of Web Definition, “Highlight”

(vii)

Arguments

Whether Claims 1 - 24 were properly rejected under §103 as being unpatentable over Microsoft FrontPage Screen Shots in view of Khan

In the Microsoft FrontPage Screen Shots, a first sub-folder that contains a file is shown to be copied into a second sub-folder that also contains files. But note that this is a sub-folder that is copied into another sub-folder. It is not the content of a first sub-folder that is copied into a second sub-folder. More specifically, Microsoft FrontPage Screen Shots does not teach the steps of **creating a copy of bookmarks stored in the first sub-folder; and storing the copy into the second sub-folder** as claimed. Further, the Microsoft FrontPage Screen Shots reference is not directed toward linking a first sub-folder to a second sub-folder in a bookmark folder that contains bookmarks.

The Examiner asserted that copying a first sub-folder into a second sub-folder is the same as creating a copy of the bookmarks stored in the first sub-folder and storing the copy into the second sub-folder. Applicants disagree.

To illustrate the difference between the claimed invention and the Examiner's assertion, when a first sub-folder is copied into a second sub-folder and the second sub-folder is accessed, based on the teachings of the reference, the original content of the second sub-folder and **the first sub-folder** is displayed (see page 5 of Microsoft FrontPage Screen Shots). By contrast, when a copy of the bookmarks stored in the first sub-folder is created and stored into the second sub-folder and the second sub-folder is accessed, according to the present invention, both the original bookmarks of the second sub-folder and the copied bookmarks are displayed (see page 19, lines 19 – 28 of the Application).

The Examiner further asserted, for the sake of argument, that page 7 of the Microsoft FrontPage Screen Shots reference teaches when accessing the second sub-folder, the original content of the second sub-folder and the content of the first sub-folder are displayed. But it should be noted that it is only after the first sub-folder stored within the second sub-folder is accessed that the content of the first sub-folder is displayed in conjunction with the content of the second sub-folder.

It is a well settled law that in considering a Section §103 rejection, the subject matter of the claim "as a whole" must be considered and analyzed. In the analysis, it is necessary that the scope and contents of the prior art and differences between the art and the claimed invention be determined. *Graham v. John Deere Co.*, 383 U.S. 1 (1966).

Thus, Applicants reiterate that the Microsoft FrontPage Screen Shots reference does not teach the steps of **creating a copy of bookmarks stored in the first sub-folder; and storing the copy into the second sub-folder** as claimed. Since the Microsoft FrontPage Screen Shots reference is used in combination with Khan to reject the claims, Applicants submit that the claims are allowable.

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Whether Claim 25 was properly rejected under §103 as being unpatentable over Microsoft FrontPage Screen Shots in view of Khan and further in view of Web Definition, "Highlight"

Claim 25 includes the limitations of copying all bookmarks stored in the first sub-folder into the second sub-folder, and assembling all bookmarks originally stored in the second sub-folder into a first group and the bookmarks copied into the second sub-folder into a second group in the second sub-folder ***such that when the second sub-folder is opened only bookmarks are displayed***, the bookmarks in the first group being highlighted to distinguish the bookmarks in the first group from the bookmarks in the second group.

In rejecting the claim, the Examiner did not assert that any of the references teaches the limitations that only bookmarks are displayed when the second sub-folder is opened. Therefore, the Examiner did not provide a prima facie rejection of the claim. Nonetheless, it is clear from page 7 of the Microsoft FrontPage Screen Shots reference that first sub-folder is also displayed when the second sub-folder is opened.

Consequently, Applicants submit that Claim 25 is patentable over the applied references.

Based on the foregoing, Applicants kindly request reconsideration, allowance and passage to issue of the claims in the application.

Respectfully Submitted

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(viii)

Claims Appendix

1. (Previously presented) A computer implemented method of linking a first sub-folder to a second sub-folder in a bookmark folder comprising the steps of:

creating a copy of bookmarks stored in the first sub-folder; and

storing the copy into the second sub-folder.
2. (Previously presented) The computer implemented method of Claim 1 further including the step of marking said copy as having been originated from said first sub-folder.
3. (Previously presented) The computer implemented method of Claim 2 wherein when the second sub-folder is accessed the bookmarks originally stored therein and the copy are displayed in a distinguishing manner.
4. (Previously presented) The computer implemented method of Claim 3 wherein the distinguishing manner includes displaying the copy under a title.
5. (Previously presented) The computer implemented method of Claim 4 wherein the title is the name of the first sub-folder.
6. (Previously presented) The computer implemented method of Claim 5 wherein the distinguishing manner includes highlighting the copy.

7. (Original) A computer program product on a computer readable medium for linking a first sub-folder to a second sub-folder in a bookmark folder comprising:

code means for creating a copy of bookmarks stored in the first sub-folder;
and

code means for storing the copy into the second sub-folder.

8. (Original) The computer program product of Claim 7 further including code means for marking said copy as having been originated from said first sub-folder.

9. (Original) The computer program product of Claim 8 wherein when the second sub-folder is accessed the bookmarks originally stored therein and the copy are displayed in a distinguishing manner.

10. (Original) The computer program product of Claim 9 wherein the distinguishing manner includes displaying the copy under a title.

11. (Original) The computer program product of Claim 10 wherein the title is the name of the first sub-folder.

12. (Original) The computer program product of Claim 11 wherein the distinguishing manner includes highlighting the copy.

13. (Previously presented) A computer implemented apparatus for linking a first sub-folder to a second sub-folder in a bookmark folder comprising:

means for creating a copy of bookmarks stored in the first sub-folder; and

means for storing the copy into the second sub-folder.

14. (Previously presented) The computer implemented apparatus of Claim 13 further including means for marking said copy as having been originated from said first sub-folder.
15. (Previously presented) The computer implemented apparatus of Claim 14 wherein when the second sub-folder is accessed the bookmarks originally stored therein and the copy are displayed in a distinguishing manner.
16. (Previously presented) The computer implemented apparatus of Claim 15 wherein the distinguishing manner includes displaying the copy under a title.
17. (Previously presented) The computer implemented apparatus of Claim 16 wherein the title is the name of the first sub-folder.
18. (Previously presented) The computer implemented apparatus of Claim 17 wherein the distinguishing manner includes highlighting the copy.
19. (Original) A computer system for linking a first sub-folder to a second sub-folder in a bookmark folder comprising:

at least one memory device for storing code data; and

at least one processor for processing said code data to create a copy of bookmarks stored in the first sub-folder and to store the copy into the second sub-folder.

20. (Original) The computer system of Claim 19 wherein the processor processes the code data to further mark said copy as having been originated from said first sub-folder.
21. (Original) The computer system of Claim 20 wherein when the second sub-folder is accessed the bookmarks originally stored therein and the copy are displayed in a distinguishing manner.
22. (Original) The computer system of Claim 21 wherein the distinguishing manner includes displaying the copy under a title.
23. (Original) The computer system of Claim 22 wherein the title is the name of the first sub-folder.
24. (Original) The computer system of Claim 23 wherein the distinguishing manner includes highlighting the copy.
25. (New) A computer implemented method of linking a first sub-folder to a second sub-folder in a bookmark folder comprising the steps of:

copying all bookmarks stored in the first sub-folder into the second sub-folder; and

assembling all bookmarks originally stored in the second sub-folder into a first group and the bookmarks copied into the second sub-folder into a second group in the second sub-folder such that when the second sub-folder is opened only bookmarks are displayed, the bookmarks in the first group being highlighted to distinguish the bookmarks in the first group from the bookmarks in the second group.

(ix)

Evidence Appendix

No evidence was submitted pursuant to 37 C.F.R. §§ 1.130, 1.131 and 1.132 nor was there any evidence entered by the Examiner relied upon by Appellants in this appeal.

(x)

Related Proceedings Appendix

There are no decisions rendered by a court or the Board that would have a bearing on the Board's decision in the pending appeal.